

Appl. No. 09/286,119  
Amndt dated Sept. 18, 2003  
Reply to Office Action of June 25, 2003

REMARKS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments and the following remarks.

As discussed briefly with the Examiner on August 27, 2003, and on September 9, 2003 enclosed please find an amendment after allowance. The subject of the discussions with the Examiner are enclosed in the remarks. The applicant respectfully requests entry of this amendment. In particular, claims 53 and 60 have been amended to remove the reference to the transfer support being formed from a "gas-tight thermoformable material". New claim 61 addresses this feature instead. Previously submitted claims 35 and 36 did not contain the feature that the transfer material is made from a "gas-tight thermoformable material". In addition, the applicant believes that a transfer support made from a non gas-tight thermoformable material is supported in the specification on page 10 lines 22-24 and on page 11. The applicant is amending claims 53, 56 and 60 and adding new claim 61 because as of the filing of the Amendment on May 27, 2003, the applicant did not want to include this feature in independent

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claims 53 and 60 but rather wanted to have this feature in a dependent claim.

The applicant also believes that there is no substantial amount of additional work necessary for review since the applicant believes that no new search is needed and that the claims as amended would be sufficient to overcome the references cited. For example, the feature of the transfer support being a "gas tight thermoformable material" was not included in previously filed independent claims 35 and 36 which were reviewed for allowance based upon the art on record. In addition, the applicant believes that the claims as presented in the present amendment and the arguments for patentability presented in the previously filed amendment on May 27, 2003 were sufficient to grant allowance based upon the scope of the now amended claims. In particular, the present invention in independent claims 53 and 60 differs significantly from the references cited.

The applicant believes that claims 53-60 are patentable over the above cited references, in particular Claveau and Deloode because the process of claim 53 and the associated apparatus of

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claim 60 are entirely different from both Claveau and Deroode and the applicant believes that even the combination of Claveau and Deroode would not teach the process according to claim 53 or the apparatus according to claim 60.

Claveau differs from the process of claim 53 and the apparatus of claim 60 for the following reasons: 1) Claveau requires an additional envelope to enclose and press down on inkers; 2) Consequently, Claveau does not disclose that these inkers are capable of performing the process of the transfer of material of claim 53 and does not disclose that these inkers are formed similar to the transfer support of claim 60; 3) the apparatus of Claveau and the process for applying inks using the design of Claveau is consequently much more complicated than with the present invention of the process of claim 53 or the apparatus of claim 60.

For example, Claveau discloses a process and a system for transferring artwork or decoration via inkers 3' having decorations 31 that are pressed on via separate superimposed membranes 8a and 8b.

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In contrast, claim 53 states the following:

providing an envelope formed from a transfer support which is adapted to receive the artefact..., wherein said step of providing said envelope comprises forming said envelope from said transfer support so that said open end is defined by edge portions of said transfer support;

Thus, because the process of claim 53 results in the providing of an envelope from the transfer support, claim 53 and associated claim 60 differs from Claveau.

Furthermore, Claveau does not disclose that the inkers 31, that contain decorations 31, are capable of performing the functions of the transfer support of claim 53 such as transferring ink or decorations to an artefact. Instead, claim 53 states:

sucking air from an open end of said envelope to cause said transfer support to adhere to both sides of said artefact wherein ~~said transfer support is made from a gas-tight thermoformable material;~~

The applicant believes that this step signifies the difference between the present invention in claim 53 and Claveau in that because the transfer support can be used to transfer the

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artwork without an additional envelope, the process is much simpler with the present invention.

For example, with *Claveau*, the separate structure of the inkers 3' having decorations 31 and the membranes 8a and 8b create a more complex and inefficient structure and therefore process than that of claim 53 which involves only one transfer support having a decoration. The design of *Claveau* could result in displacements occurring between the membranes 8a and 8b and the inkers 3' which result in a reduced accuracy in the application of the decoration to the artefact and a decrease in the application quality.

*Deroode* differs from the process of claim 53 and the apparatus of claim 60 for the following reasons: 1) *Deroode* discloses a process that involves additional complex machinery; 2) *Deroode* also discloses that the object for decoration must be placed on this machinery; 3) *Deroode* blocks or seals the ends of the transfer support; and 4) in *Deroode* the artefact is only coated on one side.

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For example, Deroode discloses a process that involves a flexible support skin 15 that is blocked between complicated machinery involving a frame 27 and a counter frame 26 which is positioned to form a vacuum in chamber 20.

In contrast, the process according to claim 53 discloses the following step:

sucking air from an open end of said envelope to cause said transfer support to adhere to both sides of said artefact wherein ~~said transfer support is made from a gas tight thermoformable material.~~

Thus, according to the step above the transfer support of claim 53 forms its own vacuum wrapping around the artefact while the process of Deroode involves complicated external machinery to apply the artwork.

In addition as stated above, the object to be decorated, for example, spectacles or glasses must be placed on a movable support 30 which is movable into a position for application by flexible support skin 15. In contrast, the envelope or artefact of claims 53 and 60 does not need to be moved on a movable support. Thus, Deroode differs because the flexible support skin

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15 must be blocked between frame 27 and counter frame 26, and the object to be decorated must be moved on a movable plate 31 to contact support skin 15 to form a sealed vacuum chest 20 which is sealed by frame 27 clamping down on counter frame 26 to close slit 28 and form a sealed vacuum chamber. This results in the apparatus and the process in Deroode being much more complicated than the process of claim 53 or the apparatus of claim 60 which only requires that the transfer support be formed as an envelope.

For example, the process as in claim 53 states:

and wherein during said sucking step, said envelope is so arranged as to retain flexibility along its periphery, thereby allowing said pressure to be applied to said pattern directly by said transfer support.

Thus, because the envelope retains its flexibility in its peripheral edge, it does not need to be blocked by the frame 27 and counter frame 26 of Deroode. Thus, the process of claim 53 and the design of claim 60 do not need the complicated additional machinery of Deroode.

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Finally, despite the complicated nature of Deroode, it does not allow the artifact to be decorated on both sides. The present invention as claimed in claims 53 and 60 is directed towards a process and an apparatus for coating the artifact on both sides.

In addition, the applicant believes that it would be improper to combine the disclosures of Claveau and Deroode together because as stated in *In Re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d, 1596, 1598 (Fed Cir., 1980) there must be "some objective teaching in the prior art that would lead the individual to combine the relevant teachings of the references." The applicant believes that the references to Claveau and Deroode with relation to claims 53 and 60, actually teach away from each other.

First, these two documents do not relate to the same sublimation technology. Claveau relates to the decoration of articles on the entire surface by means of elastic membranes pressing on the transfer support while Deroode relates to the partial decoration of an object by pressing against only one side of the object. The heating processes of Deroode and Claveau

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differ as well. For example, with Claveau, the heating step occurs after the vacuum is formed via the envelope and the inker. With Deroode, the sheet or transfer/support is heated first, and then the object to be decorated is pressed against the heated transfer support. Another difference between these two references is that Claveau teaches a system and a process which is performed using a portable device such as an envelope or an elastic membrane 6 which is entirely different than the design of Deroode which includes a rigid vacuum chamber 20.

The one common element between Claveau and Deroode is that both use external elements to apply pressure onto a transfer support to decorate an object. However, this feature is certainly one element in which the present invention in claims 33 and 60 differs from Claveau and Deroode. Claveau applies pressure using an external envelope which applies pressure on a transfer support or an inker, while Deroode uses a frame 27, a counter frame 26, a vacuum chest 20 and a bracket 30 all working together so that a flexible support skin can be used to apply a decoration to the artifact.

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With the present invention as claimed in claims 53 and 60, the transfer support itself is shaped as an envelope which doesn't need any additional support for applying a decorative ink to the artefact. Thus, with the present invention, the transfer of material is much less expensive than with Claveau because it does not involve using external, and more expensive envelope or membrane or using an external complicated and possibly more expensive machinery to apply the ink or decoration. Thus, the present invention not only differs, it provides a less expensive more simple solution than that of the prior art.

Thus, the applicant believes that the differences between the present invention as described in independent claim 53 and 60 and Deroode and Claveau would mean that independent claims 53 and 60 are patentable over the above cited references and therefore Deroode and Claveau should not be combined to render claims 53 and 60 unpatentable. Thus, because the applicant believes independent claims 53 and 60 are allowable, their associated dependent claims should be allowed, as well.

Therefore, with the filing of the enclosed Request for Continued Examination, the applicant respectfully requests entry

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of the above amendments to the claims after allowance because the applicant believes that the claims as amended are still patentable over the references cited taken either singly or in combination.

Respectfully submitted,

ITALO GOFFI ET AL

*William C. Collard*

William C. Collard, Reg. No. 38,411  
 Allison C. Collard, Reg. No. 27,532  
 Edward R. Freedman, Reg. No. 26,048  
 Attorney for Applicants

COLLARD & ROE, P.C.  
 1077 Northern Boulevard  
 Roslyn, New York 11576  
 (516) 365-9902

WCC:kkw

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I hereby certify that this correspondence is being sent by facsimile transmission to the U.S.P.T.O. to Patent Examiner J. Lorenzo et Group No. 1734, to 1 703-872-9622 on September 18, 2003.

*William C. Collard*  
 William C. Collard

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